

BEST AVAILABLE COPY



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20591
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/176,418	06/20/2002	Erik S. Wallen	UNMB-0130-1	9926

22506 7590 12/13/2002

JAGTIANI + GUTTAG
10379-B DEMOCRACY LANE
FAIRFAX, VA 22030

EXAMINER

DEACROIX MUIRHEI, CYBILLE

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 12/13/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

BEST AVAILABLE COPY

Office Action Summary	Application No. 10/178,418		Applicant(s) WALLEN ET AL	
	Examiner Cybille Delacroix-Muirhead		Art Unit 1814	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 20 June 2002 and 31 October 2002.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 24-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 24-26 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

BEST AVAILABLE COPY

Application/Control Number: 10/176,418

Page 2

Art Unit: 1614

DETAILED ACTION

The following is responsive to the Preliminary amendments received June 20, 2002 and Oct. 31, 2002.

Claims 1-23 are cancelled. New claims 24-26 are added.

Claims 24-26 are currently pending.

Information Disclosure Statement

Applicant's Information disclosure Statement received June 20, 2002 has been considered in part, i.e. US patents only. The remaining references will be considered upon receipt of the parent applications. Please see Applicant's copy of the 1449 submitted herewith.

Claim Objections

1. Claims 24-26 is objected to because of the following informalities: in claim 24, line 5, the phrase "associated therewith" after "antigens" should be deleted since this is already set forth at line 3 of claim 24. Additionally, there are two "." at the end of claim 24. One of them should be deleted. In claim 25, line 9, after "column", the word --to-- should be added. In claim 26, lines 1 and 2, the term "complexes" should read --complex-- so that it is consistent with line 1 of claim 26. Appropriate correction is required.

BEST AVAILABLE COPY

Application/Control Number: 10/176,418

Page 3

Art Unit: 1614

Claim Rejections - 35 USC § 112

2. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, the term "substantially purified" renders the claim vague and indefinite because it is not clear what is meant or encompassed by "substantially purified". Moreover, Applicant's specification does not define such a limitation. Instead the specification appears to be directed to method for producing "purified" heat shock protein products. One of ordinary skill in the art would not be readily apprised of the scope of the claimed invention. The metes and bounds of the patent protection desired is uncertain.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

BEST AVAILABLE COPY

Application/Control Number: 10/176,418

Page 4

Art Unit: 1614

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 24-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,747,332. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and USPN '332 claim a method for purifying heat shock protein complexes comprising adding a heat shock protein complex associated with either one of polypeptides, peptides, denatured proteins or antigens to an ADP matrix column containing an ADP matrix to bind the heat shock protein complexes to the ADP matrix; and adding a buffer containing ADP to the column to remove the heat shock protein complexes in an elution product; and a method for synthesizing heat shock protein complexes comprising adding a heat shock protein to an ADP matrix column to bind the heat shock protein, adding a complexing solution, and adding a buffer containing ADP to the column to remove the heat shock protein complex in an elution product.

Application/Control Number: 10/176,418

Page 5

Art Unit: 1614

The difference between the instant application and USPN '332 is that the instant application claims methods wherein the heat shock protein complexes are non-hsp70 heat shock protein complexes. However, the scope of the claims of the instant application of those of USPN '332 overlap because the claims of USPN '332 and the instant application recite similar steps and further because the broader claims of USPN '332 are open to and encompass the more specific methods of the instant application.

5. Claim 26 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,066,716 and claims 1-18 of U.S. Patent No. 6,433,141 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and USPN '716 and '141 claim purified ADP-heat shock protein-peptide complexes wherein the heat shock protein may be gp96, hsp90, grp94, hsp60, hsp65, etc.

The claim of the instant application differ from those of USPN '716 and '141 in that the claims of USPN '716 and '141 claim a specific heat shock protein within the claimed complexes whereas the claimed invention recites that the complexes are non-hsp70 heat shock protein complexes. However, the scope of the claim of the instant application and the claims of USPN '716 and '141 overlap because the specific heat shock proteins claimed in USPN '716 and '141 are non-hsp70 heat shock proteins. Moreover, the claim of the instant application is broader and encompasses the more specific purified ADP-heat shock protein-peptide complexes of USPN '716 and '141.

BEST AVAILABLE COPY

Application/Control Number: 10/176,418

Page 6

Art Unit: 1614

Conclusion

Claims 24-26 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM 

Dec. 11, 2002


Cybille Delacroix-Muirheid
Patent Examiner Group 1600

BEST AVAILABLE COPY

Notice of References Cited	Application/Control No. 10/176,418	Applicant(s)/Patent Under Reexamination WALLEN ET AL.	
	Examiner Cybille Delacroix-Muirhead	Art Unit 1614	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A US-6,433,141 B1	08-2002	WALLEN et al.	530/350
	B US-			
	C US-			
	D US-			
	E US-			
	F US-			
	G US-			
	H US-			
	I US-			
	J US-			
	K US-			
	L US-			
	M US-			

FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
	O				
	P				
	Q				
	R				
	S				
	T				

NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Data, Publisher, Edition or Volume, Pertinent Pages)
	U
	V
	W
	X 12/11/02

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(e).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.